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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,842	12/09/1999	SATORU SAWADA	12924(JA998-	8134

7590 01/17/2006

SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER	
SHERR, CRISTINA O	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/457,842	SAWADA ET AL.	
	Examiner	Art Unit	
	Cristina Owen Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-16 and 21-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-16 and 21-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to applicant's amendment filed October 21, 2005. Claims 1, 2, 3, 10, 13, and 21 have been amended. Claims 9, and 17-20 have been canceled. Claim 25 has been newly added. Claims 1-8, 10-16 and 21-25 are currently pending in this case.

Response to Arguments

2. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-8, 10-16 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatesan et al (US 6,801,999) in view of Huseman et al (US 6,192,349).

5. Regarding claim 1 –

Venkatesan discloses a data charging system for charging for the use of object data (e.g. abstract), the system comprising: a server machine for generating contents containing a plurality of types of object data (e.g. fig 1), wherein said data charging apparatus comprises: data reading logic for reading out said recognition data and said charging data from said recording medium (e.g. col 5 ln 30-35); a separator for

separating said object data from said contents (e.g. col 5 ln 40-45) a recognition logic for identifying the specific type of said separated object data by using said recognition data (e.g. col 5 ln 45-50); an accounting logic for dynamically charging for the use of said separated object data, based on the type of data said separated object data is, as determined by using said recognition data, and by using said charging data which has been read out from the recording medium (e.g. col5 ln 60-65), and a writing logic for writing, as part of said charging data in the recording medium, the results of charging for the use of said separated object data (e.g. col 5 ln 55-60).

6. Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii) recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client machine' including a data charging apparatus for charging using said IC card to charge for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

7. It would be obvious to one of ordinary skill in the art to combine the teachings of Venkatesan and Huseman, as both are in the same area and because smart cards or IC cards are a convenient user-friendly way of accessing and paying for data or other objects.

8. Regarding claim 2 –

Venkatesan discloses a content generator on a server machine for embedding digital watermarks in object data of a specific type and generating contents in a data charging

system which records charging data used for paying for object data contained in said contents and recognition data used for identifying the type of object data in said contents, , based on the specific type of data said object data is, as determined by using said recognition data, and by using said charging data and said recognition data which have been recorded in said recording medium (e.g. fig. 1, abstract, col 5 ln 30-65).

9. As above, Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii) recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client machine' including a data charging apparatus for charging using said IC card to charge for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

10 It would be obvious to one of ordinary skill in the art to combine the teachings of Venkatesan and Huseman, as both are in the same area and because smart cards or IC cards are a convenient user-friendly way of accessing and paying for data or other objects.

11. Regarding claim 3 –

Venkatesan discloses in a data charging system including a server machine which records, charging data for paying for object data and contained in contents and recognition data used for identifying the type of object data in said contents and pays for the use of said object data by using said charging data and said recognition data which has been recorded in the recording medium, a client machine including a data charging

apparatus comprising: a data reading logic for reading said recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, a recognition logic for identifying the type of said separated object data by using said recognition data read out from the recording medium,
an accounting logic for dynamically charging for the use of said separated object, based on the type of data said separated object data is, as determined by using said recognition data, and data by using said charging data which has been read out from the recording medium, and a writing logic for writing, as part of said charging data in the recording medium, the results of charging for the use of said separated object data (e.g. col 5 ln 30-62)

12. As above, Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii) recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client machine' including a data charging apparatus for charging using said IC card to charge for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

13 As above, it would be obvious to one of ordinary skill in the art to combine the teachings of Venkatesan and Huseman, as both are in the same area and because smart cards or IC cards are a convenient user-friendly way of accessing and paying for data or other objects.

14. Regarding claim 4 –

Venkatesan discloses the data charging apparatus according to Claim 3, wherein said contents comprise said object data and said recognition data for recognizing this object data, said separator separates said object data and said recognition data from said contents, said recognition logic recognizes said object data, based on said recognition data 'which has been separated from said contents and on said recognition data which has been read out from said recording medium, and said accounting logic charges for said object data by using said charging data which has been read out (e.g. col 1 ln 35-62).

15 As above, it would be obvious to one of ordinary skill in the art to combine the teachings of Venkatesan and Huseman, as both are in the same area and because smart cards or IC cards are a convenient user-friendly way of accessing and paying for data or other objects.

16. Regarding claim 5 –

Venkatesan discloses a data charging apparatus comprising a watermarking logic for embedding digital watermarks in said object data which has been separated from said contents, wherein said separator separates said object data and said recognition data from said contents, said recognition logic recognizes said object data, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from said recording medium, and said accounting logic charges for said object data embedded with said digital watermarks (e.g. col 5 ln 50-65).

17. Regarding claim 6 –

Venkatesan discloses a data charging apparatus according to Claim 3, wherein a digital watermark is embedded in said object data in said contents, said data charging apparatus further comprising a means for detecting if said object data is embedded with said digital watermark, said separator separating said object data and said recognition data from said contents, said recognition logic recognizing said object data, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from said recording medium, and said accounting logic charging for said object data only if said object data is found to be embedded with said digital watermark (e.g. col 5 ln 50-65).

18. Regarding claims 7-8 –

Venkatesan discloses a data charging apparatus wherein said charging data recorded on said recording medium contains at least payment data which indicates payment made in advance for the use of said object data, and said accounting logic charges for the use of said object data within limits of an amount indicated by said payment data contained in said charging data and wherein said charging data recorded on said recording medium further contains unit price data representing .an accounting unit for the use of said object data and a price corresponding to the accounting unit, said data charging apparatus comprising an accounting unit detection logic for detecting unit accounting amount data which represents an amount of said accounting unit for the object data which has been separated from said contents, L.

said accounting logic charging within the limits of the amount indicated by said payment data, based on said unit price data contained in said charging data which has been read

out and on the unit accounting amount data which has been detected. (e.g. col 22 ln 42-60).

19. Regarding claim 10 –

Venkatesan discloses a data charging method for using a server machine for generating contents which contain a plurality of types of object data and recognition data used for the identifying this object data in the generated contents, recording, in an IC card including a recording medium, (i) charging data for paying for said object data and (ii) the recognition data used for identifying the specified type of the object data, and charging for the use of said object data by using said charging data and said recognition data which have been recorded, comprising the steps of: delivering the generated contents to a client machine; and using the client machine for reading said recognition data and said charging data, separating said object data from said contents, identifying the specified type of said separated object data by using said recognition data which has been read out to charge dynamically for the use of said separated object data, based on the specified type of data said object data is, as determined and by using said charging data which has been read out from the recording medium; and writing as part of said charging data, the results of charging for the use of said recognized object data (e.g. fig. 1, abstract, col 5 ln 30-65).

20. As above, Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii) recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client

machine' including a data charging apparatus for charging using said IC card to charge for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

21. It would be obvious to one of ordinary skill in the art to combine the teachings of Venkatesan and Huseman, as both are in the same area and because smart cards or IC cards are a convenient user-friendly way of accessing and paying for data or other objects.

22. Regarding claims 11-12 –

Venkatesan discloses a data charging method wherein said object data in said contents are embedded with digital watermarks, comprising the steps of: separating said object data and said recognition data from said contents; recognizing said object data, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from said recording medium; detecting said digital watermark embedded in said object data; and charging for said recognized object data only by using said charging data which has been read out if said object data is found to be embedded with said digital watermark; comprising the steps of: separating said object data and said recognition data from said contents; recognizing said object data, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from said recording medium; embedding digital watermarks in said separated object data; and charging for the use of the object data embedded with said digital watermarks by using said charging data which has been read out (e.g. col (e.g. col 22 ln 42-60).

23. Regarding claim13 –

Venkatesan discloses in a data charging apparatus of a data charging system which uses a server machine to record, on a recording medium, (i) charging data used for paying for object data of a specified type and contained in contents and (ii) recognition data used for identifying the specified type of the object data in said contents, and charges for the use of said object data by using said charging data and said recognition data which have been recorded; a computer program product enabling a client machine that has received said contents to execute the steps of: reading said recognition data and said charging data, separating said object data from said contents, identifying the specified type of said separated object data by using said recognition data which has been read out to charge dynamically for the use of said separated object data, based on the specific type of data said separated object data is, as determined by using said, 'recognition data, and by using said charging data which has been read out from the recording medium, and writing, as part of said charging data, the results of charging for the use of said recognized object data into said recording medium e.g. fig. 1, abstract, col 5 ln 30-65).

24. As above, Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii) recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client machine' including a data charging apparatus for charging using said IC card to charge

for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

25. Regarding claims 14-16 –

Venkatesan discloses a computer program product wherein said contents contain said object data and said recognition data used for recognition of the object data, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from the recording medium, and a charge is made for said object data in said charging step by using said charging data which has been read out; wherein the computer is made to execute the step of embedding digital watermarks in said object data which has been separated from said contents, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data which has been separated from said contents and on said recognition data which has been read out from the recording medium, and a charge is made for said object data embedded with said digital watermarks in said charging step; wherein said object data in said contents are embedded with digital watermarks, the computer is further made to execute the step of detecting that said object data is embedded with said digital watermarks, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step,

based on said recognition data which has been separated from said contents and on said recognition data which has been read out from the recording medium, and a charge is made for said object data in said charging step only if said object data is found to be embedded with said digital watermark (e.g. col 22 ln 6-24).

26. Regarding claim 21 –

Venkatesan discloses a data charging system according to Claim 1 wherein the server generates watermark information about the digital watermark and also embedded in said contents (e.g. col 5 ln 55-60).

27. As above, Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii) recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client machine' including a data charging apparatus for charging using said IC card to charge for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

28. Regarding claims 22-23 –

Venkatesan discloses a method according to Claim 11, further comprising the step of embedding in said contents information about the digital watermarks; wherein the embedding step includes the step of embedding in said contents instructions for embedding the contents with said digital watermarks. e.g. col 5 ln 55-60).

29. As above, Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii)

recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client machine' including a data charging apparatus for charging using said IC card to charge for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

30. Regarding claim 24-25 –

Venkatesan discloses a data charging system according to Claim 1, wherein: the content generator also puts recognition data in said contents; and the object data is identified based on the recognition data in said contents and said recognition data read from the recording medium; wherein the recognition logic compares the recognition data read out with the recognition data separated from said contents to determine if said two kinds of recognition data match e.g. col 5 ln 55-60).

31. As above, Huseman discloses (which Venkatesan does not) an IC card including a recording medium for recording (i) charging data for paying for said object data and (ii) recognition data for identifying the type of the data said object data, and a client machines for receiving said contents generated by the server machine, the client machine' including a data charging apparatus for charging using said IC card to charge for the use of said object data by using said charging data and said recognition data which have been recorded on said IC card (e.g. col 1 ln 35-62).

32. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

34. Rhoads (US 6,345,104) discloses digital watermarks and methods for security documents.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER